

REMARKS

Claims 1, 5-8 and 12 have been amended. Claims 16-21 have been added. Claims 1, 5-8, 12 and 16-21 remain for further consideration. No new matter has been added. The rejections shall be taken up in the order presented in the Official Action.

1-2. Claims 1, 5-7 and 12 currently stand rejected for allegedly being obvious in view of the combined subject matter disclosed in U.S. Patent 6,647,327 to Wolf et al (hereinafter “Wolf”) and published U.S. Patent Application 2003/0021262 to Ma et al (hereinafter “Ma”).

The Official Action states that Wolf fails to specifically disclose that incoming data is formatted as Bluetooth data. The Official Action then alleges “*Ma teaches an incoming data is formatted as Bluetooth data (fig. 1-2, paragraph 0004-0007,...).*” (Official Action, pg. 3). The Official Action further contends “[t]herefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an incoming data [] formatted as Bluetooth data as taught by Ma with Wolf teaching in order to provide each Bluetooth device may communicate with a number of other Bluetooth device[s].” (Official Action, pg. 3). It is respectfully submitted that a case of prima facie obviousness has not been established.

WOLF IS NOT PRIOR ART

Wolf is assigned of record to Becker GmbH. The instant application is also assigned of record to Becker GmbH. The parent to Wolf issued as U.S. Patent 6,647,327 on November 11, 2003. Wolf is a continuation of U.S. Patent 6,647,327, and thus the earliest date that Wolf is available as prior art with respect to the instant co-owned application is its issue date of November 11, 2003. That is, the U.S. filing date of the parent application of Wolf is not the

effective date of Wolf as a prior art reference against the instant application, since the instant application and Wolf are commonly owned (see 35 U.S.C. §103(c)).

A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN ESTABLISHED

The Official Action suggests a position that is best summarized as being that Bluetooth was known at the time of the invention, and therefore one of ordinary skill would have been motivated to combine Bluetooth with the system disclosed in Wolf since Bluetooth existed. Significantly, the Official Action is noticeably missing any reasoned statement regarding why a skilled person at the time of the invention would have been motivated to modify Wolf based upon the teachings of Ma as alleged in the Official Action.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.” In re Geiger, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). “*Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, ‘[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.’”* In re Laskowski, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In addition, “[w]hen the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why the combination of the reference teachings is proper.” Ex parte Stone, 2 U.S.P.Q.2d 1788, 1790 (Bd.App. & Int’f 1986) (emphasis added).

As noted above, it is fundamental that obviousness can not be established absent some teaching to combine the references, or a suggestion or incentive supporting the combination of references. See In re Geiger, at 1278 (Fed. Cir. 1987). In the instant case the Official Action is

lacking the necessary factual, non-conclusionary explanation why the combination of the Wolf and Ma is proper. Hence, it is respectfully submitted that a prima facie case of obviousness has not been presented since there is no proper teaching, suggestion or incentive that would lead one of ordinary skill in the art to modify Wolf based upon the teachings of Ma as alleged in the Official Action to create the claimed invention.

Again, the conclusionary position of the Official Action that the mere existence of Bluetooth would be enough motivation for a skilled person at the time of the invention to modify Wolf as alleged in the Official Action is simply not enough to establish a prima facie case of obviousness. The prior art must suggest the combination. The Official Action is missing any reasoned statement regarding where the motivation to combine is originating from.

The indication that claim 8 is allowed is noted and appreciated.

Reconsideration and allowance of claims 1, 5-8, 12 and 16-21 is respectfully requested.

If a telephone interview could assist in the prosecution of this application, please call the undersigned attorney.

Respectfully submitted,



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